

REMARKS

Status of the Claims

Claims 1-18 are pending in this application. No claims have been canceled or amended. Claims 16-18 have been added. Support for new claims 16-18 is found at page 4 in the specification, first paragraph. No new matter has been added by the above new claims.

Rejection under 35 USC 112, first paragraph

The Examiner rejects claims 1-15 as containing subject matter that is not described in the specification because the specification incorporates by reference the Japanese prior documents. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that pursuant to MPEP 608.01(p)(I.)(B), the limitations on the material, which may be incorporated by reference do not apply to applications relied on only to establish an earlier effective filing date. Neither 35 USC §119(a) or §120 places any restrictions or limitations as to how the claimed invention must be disclosed in the earlier application to comply with 35 USC 112, first paragraph. Accordingly, an application is entitled to rely upon the filing date of an earlier application, even if the earlier application itself incorporates essential material by reference to another document. As such, the rejection should be withdrawn.

Rejections under 35 USC 103(a)

The Examiner rejects claims 1-15 as obvious over Toya et al. USP 5,656,419 (Toya '419) in view of Murray USP 5,705,324 (Murray '324) and Suzuki USP 6,060,228 (Suzuki '228). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the Examiner has failed to make a proper *prima facie* case of obviousness as the cited references fail to teach what the Examiner alleges. As such, the rejection should be withdrawn.

Applicants submit that the present invention relates to a heat developable image-recording material comprising on a support, a silver-supplying layer containing substantially no photosensitive silver halide; and a separate photosensitive layer containing a photosensitive silver halide; and further containing an electron transferring agent.

Applicants submit that Toya '419 does not disclose or suggest a separate silver supplying layer containing substantially no photosensitive silver halide as claimed in the present invention. Toya '419 discloses a high sensitivity layer or a low sensitivity layer. (See column 17, lines 55-60.) In each of the disclosed layers, photosensitive silver halide is present in substantial amounts, unlike that in the present invention where there is substantially no photosensitive silver halide. As such, Toya '419 is removed as the primary reference in the obviousness rejection.

Toya '419 discloses a single layer containing all of the following: organic silver salt, organic binder, reducing agent and photosensitive silver halide; and an optional light insensitive layer.

Toya '419 does not disclose or suggest removing the photosensitive silver halide from the above-mentioned layer and placing it in a separate layer containing the photosensitive silver halide. In fact, if Toya '419 were to attempt to remove the photosensitive silver halide from the above-mentioned layer wherein said layer contains no photosensitive silver halide; such a modification would destroy the invention of Toya. As such, Toya teaches away from the present invention and fails to function as a proper primary reference in the obviousness rejection.

The secondary references are relied on by the Examiner for allegedly teaching an electron transferring agent. However, neither Murray '324 nor Suzuki '228 discloses an electron transferring agent as claimed in the present invention. Murray '324 discloses a co-developer (i.e. IS-01, -02 and -03) and Suzuki '228 discloses a contrast enhancer (i.e. formula (3), (4) and (5)). Claims 8-10 further define the electron transferring agent. Clearly, the claimed electron transferring agents are not disclosed or suggested in the secondary references.

Applicants submit that as the combination of the primary reference and the secondary references fail to disclose or suggest to one of ordinary skill in the art as demonstrated above, the Examiner has failed to make a *prima facie* case of obviousness. As such, the rejection should be withdrawn and the claims allowed.

Moreover, Applicants submit new claims 16-18, which further define "substantially no photosensitive silver halide". The maximum weight percentage is 10%. The minimum amount is no photosensitive silver halide. Toya '419 does not suggest substantially no to absolutely no amount of photosensitive silver halide.

Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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(Rev. 02/20/02)